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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,434	02/20/2004	Peter Nicholson	920709-95578	6373
79172	7590	05/19/2010	EXAMINER	
Duane Morris LLP 505 9th Street, N.W. Suite 1000 Washington, DC 20004			ISSING, GREGORY C	
			ART UNIT	PAPER NUMBER
			3662	
			MAIL DATE	DELIVERY MODE
			05/19/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/783,434

Applicant(s)

NICHOLSON, PETER

Examiner

Gregory C. Issing

Art Unit

3662

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) 33-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 15-32, 38-53 and 55-61 is/are rejected.
- 7) ☒ Claim(s) 12-14 and 54 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ ~~Notice of Informal Patent Application~~
- 6) ☐ Other: _____

1. The information disclosure statement filed 3/3/06 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it lacks the requirement of 37 CFR 1.98(a)(1)(i) for each page of the information disclosure statement to have a proper heading indicating the serial number of the application and an indication that it represents an information disclosure statement. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

2. Applicant argues that page one of the IDS is proper and therefore must be considered. The information disclosure statement is a submission as a whole and since the submission as a whole is improper the references in the IDS are not considered.

3. Claims 33-37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the previous reply filed on 7/27/09. The restriction requirement is made FINAL. Applicant is required to cancel the withdrawn claims.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-8, 11, 15-32, 39-52 and 55-61 are rejected under 35 U.S.C. 102(c) as being anticipated by Moilanen et al (2005/0068229).

6. The rejection is set forth in the previous Office Action (10/19/09) in paragraphs 6-7.

7. The applicant argues for patentability on the basis that Moilanen et al fail to teach or suggest either of the steps of “determining on the basis of at least one predetermined criteria the likelihood that each of the potentially visible satellites will actually be used” and “selecting a plurality of satellites . . . having the greatest likelihood that the mobile terminal will use that satellite when determining its position.” In support, applicant alleges that (1) Moilanen et al do not disclose that the probabilities are based on “likelihood of use” and (2) “likelihood of reception” and “likelihood of use” are not the same. Applicant further states that the “likelihood of use” is related to the use of DOP in the satellite selection.

8. The argument has been considered but is not convincing. The determination of which satellites are potentially visible to the mobile terminal is set forth in [0048]-[0051] and refers to step 304 of Figure 3, as accepted by the applicant. Subsequently, Moilanen et al teach making a determination of the visibilities of satellites which are in the potentially visible list with respect to the mobile station on the basis of a criterion that the probability of the mobile station will use a selected satellite as set forth in [0052], step 305; if it is capable of being decoded then the probability of being used is high, likewise if it is not capable of being decoded then the probability of use is low. Finally, Moilanen et al teach selecting a plurality of satellites from the satellites estimated to be visible to the mobile station [0053]-[0054] wherein the plurality of the M most likely to be visible are selected wherein $M > N$ where N is the minimum number of satellites needed for determining a position of a mobile terminal. Applicant's allegation that Moilanen et al differs from the claimed subject matter since probabilities based on *likelihood of reception* (decoding) is not equivalent to probabilities based on *likelihood of use* is not agreed

with since a probability associated with the capability of a signal being properly decoded is deemed to represent a probability that it will/will not be used. If the probability of proper decoding is high, then the probability of use is high whereas if the probability of proper decoding is low, then the probability of use is low.

9. Claims 9, 10, and 53 rejected under 35 U.S.C. 103(a) as being unpatentable over Moilanen et al in view of any one of Maki, Shenyblat, Nishikawa and Myers.

10. The rejection is set forth in the previous Office Action (10/19/09) in paragraphs 9-10.

11. Applicant argues the patentability of these claims on the basis of the independent claim, and more particularly on the alleged failure of Moilanen et al to teach determination of the likelihood of the satellite to be used since the secondary references do not obviate this deficiency. As set forth above, Moilanen et al is deemed to teach the determination of the probability of use. Applicant argues that the use of the DOP is indicative of the "likelihood of use". Although the additional use of DOP is not required for the scope of the independent claim, in light of the teachings of Moilanen et al to select more than a minimum number of satellites/groups of satellites as well as the use of additional criteria in the selection and the conventional if not inherent function of the use of DOP in GPS receivers to estimate the best set of satellites, as evidenced by any one of Maki, Sheynblat, Nishikawa et al and Myers, the additional use of GOP in the selection of plural prioritized sets of satellites would have been obvious to the skilled artisan since it is known in the art and the combination would yield a predictable result of a selection of satellites having the best probability of use in the mobile terminal position determination.

12. Claims 12-14 and 54 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory C. Issing whose telephone number is (571)-272-6973. The examiner can normally be reached on Monday - Thursday 6:00 AM- 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on (571)-272-6979. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gregory C. Issing/
Primary Examiner
Art Unit 3662

gci